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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/873,428 | 06/05/2001 | Toshio Tokunaga | Q62667 | 5145 |

7590 07/16/2003
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

KNABLE, GEOFFREY L

| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,428

Applicant(s)

TOKUNAGA, TOSHIO

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**: 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim 11 description that the stopper is positioned "at least partially" between the pistons is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. Note that the original disclosure never describes the stopper in this manner and further it is not considered that the figures can be said to describe what is now claimed. Note for example that defining that the stopper is "at least partially" between the pistons indicates that the stopper is either partially or fully between the pistons whereas the original disclosure does not describe the invention in this manner or indicate possession of the invention described in this manner.

The new claim 12 recitation that a "substantial portion" of the inner piston is between the outer piston and segments is likewise not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is new matter. In particular, defining that a "substantial portion" of the piston is so located suggests that the invention contemplates any embodiment where simply a substantial portion of the inner piston is so located, this being inclusive of

embodiments where other portions of the piston are not so located, whereas the depicted embodiment would appear to show the entire inner piston so located.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyanaga et al. (US 5,223,074) as applied in the last office action.
4. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyanaga et al. (US 5,223,074) as applied in the last office action.
5. Applicant's arguments filed May 6, 2003 have been fully considered but they are not persuasive.

Applicant first stresses that the operation of Miyanaga's pistons is "entirely different" from those of the instant application. It is agreed that applicant's disclosed pistons are structured and function in a substantially different manner from those of Miyanaga. At issue however is whether the *claimed* tire building apparatus differs from that of the reference, it being the examiner's position that the present claims do not patentably distinguish the Miyanaga structure for reasons set forth in detail in the last office action.

It is also argued that "only flange wall 16 serves as a stopper for the outer piston (second piston 11). Therefore, the flange wall 16 is entirely different from the stopper defined in the present invention." This argument has been carefully considered but it is not seen what in the claims defines the stopper in any manner that defines over what is shown in the reference. Claim 1 simply defines that the stopper stops inward

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movement of the outer piston at a given position, it being again the examiner position that the flange wall 16 meets this requirement. Again, while it is agreed that applicant's described invention differs in many respects from that of the reference, nothing in the claims brings out these distinctions. It is noted for example that if claim 1 were amended so that the inner and outer pistons were defined as "axially" inner/outer along with a more complete indication of what is meant by a "back face" of the inner piston in claim 1 (i.e. note that in applicant's invention, the back face of the axially inner piston is actually the backmost part of the piston in the axially outer direction whereas in Miyanaga, what is being described as the backface (39b) is not the axially outer backmost part of the piston (10) but rather is a face intermediate the axial extremes of the piston), such a claim would better distinguish the Miyanaga reference. Support for any amendments must however be shown, it being noted as in the new matter rejections above, that any new language including statements of degree (at least partially, substantial portion, etc.) are likely not described/supported by the original disclosure.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

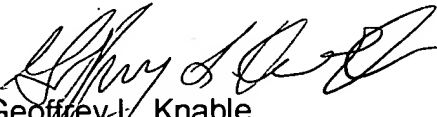
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Geoffrey L. Knable
Primary Examiner
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G. Knable
July 12, 2003